

### ARGUMENTS/REMARKS

Applicants would like to thank the examiner for the careful consideration given the present application. The application has been carefully reviewed in light of the Office action, and amended as necessary to more clearly and particularly describe and claim the subject matter which applicants regard as the invention.

Claims 1-21 remain in this application. Claims 22-23 have been withdrawn. New claims 24-26 has been added without introducing new matter.

The examiner has acknowledged that claim 21 is directed to allowable subject matter. Claims 22-23 have been withdrawn as the result of an earlier restriction requirement. In view of the examiner's earlier restriction requirement, applicant retains the right to present claims 22-23 in a divisional application.

Claims 14-20 were rejected under 35 U.S.C. §112, second paragraph, as being indefinite. Amendments to the claims correct the issues identified by the Examiner, making this rejection moot.

Claims 14-20 were objected to because of the above rejections, but because of the claim amendments, they should be allowable as indicated by the Examiner.

Claims 1, 2, 4, 6, 9, and 10 were rejected under 35 U.S.C. §103(a) as being a unpatentable over Emery (U.S. 6,228,494) in view of Smith (U.S. 1,650,049), Middleton (U.S. 3,654,027), and Molins (U.S. 3,668,045). For the following reasons, the rejection is respectfully traversed.

Claim 1, as amended, recites the step of "placing a core material onto an interior surface of a web of conductive layer material including substantially non-conductive fibers". None of the references suggest a conductive layer material including substantially non-conductive fibers, as claimed. Hence, not all the limitations are taught by the combination (as required by MPEP §2143.03), and thus claim 1 is patentable over the references.

Claims 2-5, which are dependent on claim 1, are patentable over the references for at least the same reasons as claim 1.

Further, the Examiner has not provided the proper motivation for combining the references. The burden is on the Examiner to make a prima facie case of obviousness (MPEP §2142). To support a prima facie case of obviousness, the Examiner must show that there is some *suggestion* or *motivation* to modify the reference (MPEP §2143.01). The mere fact that references *can* be combined or modified, alone, is not sufficient to establish prima facie obviousness (*Id.*). The prior art must also suggest the *desirability* of the combination (*Id.*). The fact that the claimed invention is within the *capabilities* of one of ordinary skill in the art is not sufficient, by itself, to establish prima facie obviousness (*Id.*).

The Examiner has cited no support for any such suggestion or motivation for the combination from within the references, and neither does the Examiner provide any references supporting any motivation to modify the reference(s) by making the combination. Conclusory statements of benefit, or that a step is "well known", such as provided in the Office action, is not sufficient to show obviousness.

Merely listing an advantage of the combination is not sufficient, as some rationale for combining the references must be found in the references themselves, or drawn from a convincing line of reasoning based on established scientific principles practiced by one skilled in the art that some advantage or beneficial result would be produced by the combination (MPEP §2144). Such motivation cannot be found in the application itself, as such hindsight is impermissible; the facts must be gleaned from the prior art. (MPEP §2142, last paragraph).

In this case, it appears that the only motivation for combining the references is obtained from the application itself. There is nothing in any reference to suggest that the device of Emery should be made according to the processes disclosed in the other references. Hence, for this reason as well, the rejection cannot stand, and thus the rejection of claims 1, 2, 4, 6, 9, and 10 should be withdrawn.

Further, claim 6 recites a step of "pressing said web of non-conducting core material wrapped with said web of conductive layer material by passing through a pair of rollers to form said conductive filler". The Examiner rejects this claim by responding that, as shown in Smith, it is known to press layers together for bonding them. However, Smith does not suggest pressing a web of *non-conducting core*

*material wrapped with a web of conductive layer material*, as claimed. MPEP §2143.03 specifically requires that all claim limitations must be taught by the references. None of the references suggest pressing the webs, as specified in the claim, by passing them through a pair of rollers. Accordingly, claim 6 is patentable over the references.

Claims 7-9, which depend on claim 6, are thus patentable for at least the same reasons.

Claims 3, 5, 7, 8, and 11 were rejected under 35 U.S.C. §103(a) as being a unpatentable over Emery (U.S. 6,228,494) in view of Smith (U.S. 1,650,049), Middleton (U.S. 3,654,027), and Molins (U.S. 3,668,045), and further in view of Onai (U.S. 4,889,963). For the following reasons, the rejection is respectfully traversed.

Onai does not overcome the shortcomings discussed for claims 1 or 6, above. Hence, claims 3, 5, 7, and 8 are patentable over the references for the same reason as their parent claim.

Further, claim 11 recites that the "conductive material includes substantially non-conductive fibers impregnated with a conductive resin". None of the references suggest such a limitation. Hence, claim 11 is patentable over the references for that reason.

Finally, the Examiner has not provided the proper motivation for combining the references, and hence the rejection is improper, and should be withdrawn.

Claims 1, 2, 4, 6, 9 and 10 were rejected under 35 U.S.C. §103(a) as being a unpatentable over Delon (U.S. 1,740,076) in view of Smith (U.S. 1,650,049), Middleton (U.S. 3,654,027), and Molins (U.S. 3,668,045), and further in view of Onai (U.S. 4,889,963). For the following reasons, the rejection is respectfully traversed.

Delon does not overcome the shortcomings of the references discussed for claims 1 and 6, above. Delon does not suggest a conductive material having substantially non-conducting fibers. Further, Delon suggests using a metal strips or tissue as a conducting layer. This teaches away from any existence of non-conducting fibers, and metals. And the Examiner admits that Delon does not

suggest the use of adhesive, merely stating that such use would be "obvious" without showing where the motivation exists for using such an adhesive. Finally, Delon does not provide any motivation for the processes described in the claims. Accordingly, claims 1, 2, 4, 6, 9 and 10 are patentable over the references, as are the claims dependent thereon.

Claims 3, 5, 7, 8, and 11 were rejected under 35 U.S.C. (U.S. 1,650,049,), Middleton, and Molins, and further in view of Onai. For the following reasons, the rejection is respectfully traversed.


Onai does not overcome the shortcomings addressed above for Delon, hence claims 3, 5, 7, 8, and 11 are patentable over the references. Further, yet again, no proper motivation has been provided for making the combination of references. Thus, the rejection is improper, and should be withdrawn.

In consideration of the foregoing analysis, it is respectfully submitted that the present application is in a condition for allowance and notice to that effect is hereby requested. If it is determined that the application is not in a condition for allowance, the examiner is invited to initiate a telephone interview with the undersigned attorney to expedite prosecution of the present application.

If there are any additional fees resulting from this communication, please charge same to our Deposit Account No. 16-0820, our Order No. 31125US2.

Respectfully submitted,

PEARNE & GORDON, LLP

By   
Robert F. Bodi, Reg. No. 48,540

1801 East 9<sup>th</sup> Street, Suite 1200  
Cleveland, Ohio 44114-3108  
(216) 579-1700

December 8, 2003